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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/552,650	04/19/2000	Paul Bucknell	PHB 34,339	2839

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EXAMINER

YUN, EUGENE

ART UNIT	PAPER NUMBER
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2682

15

DATE MAILED: 11/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

KS

Office Action Summary

Application No.

09/552,650

Applicant(s)

BUCKNELL ET AL.

Examiner

Eugene Yun

Art Unit

2682

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-4,6 and 8-16 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 2-4,6 and 8-16 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 December 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 10, 15, and 16 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
3. Regarding claims 10, 15, and 16, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000.

Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claim 9 is rejected under 35 U.S.C. 102(e) as being anticipated by Nodoushani (US 6,144,849).

Referring to Claim 9, Nodoushani teaches a fixed terminal 30 (fig. 2) for use in a communication system in which a mobile terminal can configure said fixed terminal by service negotiation, the fixed terminal comprising a transceiver 24 (fig. 2), a memory for storing software functions 34 (fig. 2), and a processor for controlling operation of the fixed terminal in accordance with stored software functions 32 (fig. 2), at least one of the software functions being alterable in response to the receipt of a message from said mobile terminal containing new software function plus interface software required by the processor in building the new function into an actual implementation on the fixed terminal (see col. 7, lines 32-47).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 2-4, 6, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over BT and Nodoushani et al. (US 6,144,849) in view of Niska et al. (US 6,041,228).

Referring to Claim 2, BT teaches a method of operating a radio system comprising a mobile terminal and a fixed terminal. BT does not teach the method comprising said mobile terminal transmitting a message giving parameters relating to its capabilities. Nodoushani teaches the method comprising said mobile terminal transmitting a message giving parameters relating to its capabilities (see col. 6, lines 53-66). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teachings of Nodoushani to said method of BT in order to consume less power in a mobile telephone while programming a radio system. The combination of BT and Nodoushani does not teach said fixed terminal receiving the message and configuring itself in accordance with the received parameters. Niska teaches said fixed terminal receiving the message (see col. 5, lines 21-25) and configuring itself in accordance with the received parameters (see col. 5, lines 30-37). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teachings of Niska to said method of BT in order to avoid additional costs when operating a radio system.

Referring to Claim 6, BT teaches a communication system comprising a mobile terminal and a fixed which are able to communicate with each other. BT does not teach a message transmitted by said mobile terminal giving parameters relating to its capabilities. Nodoushani teaches a message transmitted by said mobile terminal giving parameters relating to its capabilities (see col. 6, lines 53-66). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to

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provide the teachings of Nodoushani to said method of BT in order to consume less power in a mobile telephone while programming a radio system.

The combination of BT and Nodoushani does not teach said fixed terminal receiving the message and configuring itself in accordance with the received parameters. Niska teaches said fixed terminal receiving the message (see col. 5, lines 21-25) and configuring itself in accordance with the received parameters (see col. 5, lines 30-37). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teachings of Niska to said method of BT in order to avoid additional costs when operating a radio system.

Referring to Claim 3, Nodoushani also teaches the mobile terminal transmitting the required function plus software required in building a new function into an actual implementation on the fixed terminal (see col. 7, lines 32-47).

Referring to Claim 4, BT also teaches testing the air interface to ensure that configuration/reconfiguration has taken place without error (see col. 6, lines 49-53).

Referring to Claim 8, BT also teaches said fixed and mobile terminals each having a software interface (see col. 2, lines 7-21) including a memory and means for altering the memory (see col. 2, lines 27-29), and wherein at least a portion of the area of the memory has a part allocated to respective software functions, the memory altering means replacing the area of a respective part in response to a new function being downloaded (see col. 5, lines 53-58).

8. Claims 10-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over

British Telecommunications (BT) (EP 0825791) in view of Trompower et al. (US 5,950,124).

Referring to Claim 10, BT teaches a method of configuring a profile of a fixed terminal comprising:

transmitting capabilities of said fixed terminal to a mobile terminal (see col. 5, lines 18-20);

selecting by said mobile terminal parameters that match said capabilities and transmitting said parameters to said fixed terminal (see col. 5, lines 35-45);

selecting by said fixed terminal a portion of said parameters to form selected parameters and informing said second terminal of said selected parameters (see col. 5, lines 46-49); and

transmitting by said mobile terminal to said fixed terminal required information to form said profile based on said selected parameters (see col. 5, lines 53-58).

BT does not teach the capabilities including modulation type, bit rate, spreading code and number of carriers which are executed in a communication unit. Trompower teaches the capabilities including modulation type, bit rate, spreading code and number of carriers which are executed in a communication unit (see col. 5, lines 41-52).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teachings of Trompower to said device of BT in order to enhance system performance by improving data transmission rate.

Referring to Claim 11, BT also teaches requesting said capabilities of said fixed terminal by said mobile terminal (see col. 5, lines 6-8).

Referring to Claim 12, BT also teaches testing delivery integrity of said required information (see col. 6, lines 49-53).

Referring to Claim 13, BT also teaches testing delivery integrity of said required information (see col. 6, lines 49-53); and

requesting retransmission of said required information if said testing indicates an error in said delivery integrity (see col. 5, lines 53-58 and col. 7, lines 12-19).

Referring to Claim 14, BT also teaches acknowledging proper reception of said required information (see col. 6, lines 4-7).

9. Claims 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over BT and Trompower in view of Morris et al. (US 6,112,206).

Referring to Claim 15, BT teaches a communication terminal comprising:
means for transmitting capabilities of said communication terminal to another terminal (see col. 5, lines 18-20);

means for receiving parameters from said another terminal, said parameters matching said capabilities (see col. 5, lines 35-45);

means for selecting a portion of said parameters to form selected parameters and informing said another terminal of said selected parameters (see col. 5, lines 49-58);

means for receiving from said another terminal required information to form a profile of said communication terminal based on said selected parameters (see col. 6, lines 1-4); and

means for configuring said profile in response to said required information from said another terminal (see col. 6, lines 4-7).

BT does not teach said another terminal as a server. Morris teaches said another terminal as a server (see ABSTRACT noting that a server can exist on a mobile unit). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teachings of Morris to said method of BT in order to reduce error when operating a radio system.

The combination of BT and Morris does not teach the capabilities including modulation type, bit rate, spreading code and number of carriers which are executed in a communication unit. Trompower teaches the capabilities including modulation type, bit rate, spreading code and number of carriers which are executed in a communication unit (see col. 5, lines 41-52). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teachings of Trompower to said device of BT in order to enhance system performance by improving data transmission rate.

Referring to Claim 16, BT teaches a communication terminal comprising:

- a memory which stores data indicative of capabilities of said communication terminal (see col. 2, lines 27-29);
- a transmitter which transmits said capabilities to another terminal (see col. 5, lines 18-20);
- a receiver which receives parameters from said another terminal, said parameters matching said capabilities (see col. 5, lines 35-45);

a controller which selects a portion of said parameters to form selected parameters and informs said another terminal of said selected parameters (see col. 5, lines 49-58);

said receiver receiving from said another terminal required information to form a profile of said communication terminal based on said selected parameters (see col. 6, lines 1-4); and

said controller configuring said profile in response to said required information from said another terminal (see col. 6, lines 4-7).

BT does not teach said another terminal as a server. Morris teaches said another terminal as a server (see ABSTRACT noting that a server can exist on a mobile unit).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teachings of Morris to said method of BT in order to reduce error when operating a radio system.

The combination of BT and Morris does not teach the capabilities including modulation type, bit rate, spreading code and number of carriers which are executed in a communication unit. Trompower teaches the capabilities including modulation type, bit rate, spreading code and number of carriers which are executed in a communication unit (see col. 5, lines 41-52). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teachings of Trompower to said device of BT in order to enhance system performance by improving data transmission rate.

Response to Arguments

10. Applicant's arguments with respect to claims 10-16 have been considered but are moot in view of the new ground(s) of rejection.

11. Applicant's arguments filed 9/11/2003 have been fully considered but they are not persuasive.

Regarding Claims 2 and 6, the applicant argues that the Niska reference does not teach a fixed terminal receiving a message and configuring itself in accordance with received parameters. In the cited passages col. 5, lines 21-25 and col. 5, lines 30-37, the process of the fixed terminal configuring itself includes introducing itself to the network and informing the network about its capabilities. The actual act of the fixed terminal configuring itself is shown in lines 36-37. The claims are broad enough that for the reasons stated above, the Niska reference can be combined with the BT reference to read on the claims.

Regarding Claim 9, the entire system shown in fig. 2 in the Nodoushani reference is described as the fixed terminal. All the elements including reference numerals 34, 32 and the MSC are connected to each other and none of the elements are mobile elements. Therefore, the entire system (30 in fig. 2) can be a fixed terminal.

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP


§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eugene Yun whose telephone number is (703) 305-2689. The examiner can normally be reached on 8:30am-5:30pm Alt. Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vivian Chin can be reached on (703) 308-6739. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9314.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.


VIVIAN CHIN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600

Eugene Yun
Examiner
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